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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,083	10/31/2003	Wesley Scott Ashton	ASHTON0009	9725

7590
Wesley Scott Ashton
8549 Black Foot Court
Lorton, VA 22079

08/19/2010

EXAMINER

REESE, DAVID C

ART UNIT	PAPER NUMBER
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3677

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/697,083	Applicant(s) ASHTON, WESLEY SCOTT	
	Examiner DAVID REESE	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-27, 31, 36-39 and 42-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-27, 31, 36-39, and 42-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

THIS FINAL ACTION IS RESPONSIVE TO THE AMENDMENT FILED 7/21/2010.

- Claims 1-20, 28-30, 32-35, and 40-41 are canceled.
- Claims 21, 31, 36-39, and 44-45 were amended.
- Claims 21-27, 31, 36-39, and 42-48 are pending.

Claim Rejections - 35 USC § 103

[1] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[2] Claims 21-27, 36, 44, and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr., US-6,026,659, in view of Kasdin, US-3,503,127.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claims 21, 36, and 44, Kaping, Jr. teaches of a method comprising the steps of providing a mouth and tongue stud, wherein the stud further comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to

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an other end of the bar, and the first end member (14) removably attaches to the one end of the bar; mounting the bar (12) of the stud in a fistula formed in a wearer's tongue.

The difference between the claim and Kaping, Jr. is that Kaping, Jr. does not expressly disclose of the bar possessing a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, wherein the substances is dispensed into the wearer's mouth solely by dissolving the substance over time in the wearer's saliva so that he dissolved substances is free to flow from the means for dispensing into the wearer's mouth. Kasdin discloses a method for dispensing a substance such as a pill or other mixture of a sweet smelling solution, and the like, in the area of the mouth of a wearer. In addition, Kasdin further teaches that the means (15,20) for dispensing a substance (21) formed in a portion of the applicator, wherein the means (15,20) for dispensing a substances contains the substances (21) and dispensing the substance (21) into the wearer's mouth, wherein the substances (21) is dispensed into the wearer's mouth solely by dissolving the substance (21) over time in the wearer's saliva so that he dissolved substances is free to flow from the means (15,20) for dispensing into the wearer's mouth (see summary of the invention, "...The cap is aperture so that saliva can seep through the cap to dissolve the pill slowly"). In addition, Kasdin teaches that this substance has a solid form and a tablet form (claim 44).

It would have been obvious to one of ordinary skill in the art, having the disclosures of Kaping, Jr. and Kasdin before him at the time the invention was made, to modify the mouth and tongue stud of Kaping, Jr. to include means for dispensing a substance formed in a portion of the stud (and therein on or below, or on and below, the wearer's tongue), wherein the means for

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dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, wherein the substances is dispensed into the wearer's mouth solely by dissolving the substance over time in the wearer's saliva so that he dissolved substances is free to flow from the means for dispensing into the wearer's mouth, as in Kasdin. One would have been motivated to make such a combination because such a configuration of the mouth and tongue stud will provide to the user a convenient and reliable means to deliver active substances, such as a breath freshener to the user in uniform dosage over an extended period of time (see summary of the invention), as taught by Kasdin. Moreover, it would have been obvious to a person of ordinary skill in the art to have modified the mouth and tongue stud of Kasdin, as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because the means for dispensing a substance into a mouth as claimed has the properties predicted by the prior art of Kasdin, it would have been obvious to make the alteration in order to gain the commonly understood benefits and applications of such an adaptation and/or modification.

Re: Claim 46, Kaping, Jr., teaches wherein the bar (12) is a solid bar that is without an internal cavity, and the means for dispensing a substance is formed in the second end member (after the modification in view of Kasdin, it would be obvious to palace the substance in any part of said mouth and tongue stud).

[3] Claims 38 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr., US-6,026,659, in view of Sipos, US-3,600,807.

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Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 38, Kaping, Jr. teaches of a method comprising the steps of providing a mouth and tongue stud, wherein the stud further comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to an other end of the bar, and the first end member (14) removably attaches to the one end of the bar; mounting the bar (12) of the stud in a fistula formed in a wearer's tongue so that the first end member (14) and the second end member (16) hold the stud in the fistula.

The difference between the claim and Kaping, Jr. is that Kaping, Jr. does not expressly disclose of the bar possessing a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, and wherein an insert is disposed in the means for dispensing a substance and dispensing the substance into the wearer's mouth, wherein the substances is dispensed by diffusing the substance over time in the wearer's saliva. Sipos discloses a method for dispensing a substance in the area of the mouth of a wearer (see summary of the invention). In addition, Sipos further teaches of dispensing the substance into the wearer's mouth, wherein an insert (18) is disposed in the means for dispensing a substance and wherein the substances is dispensed by diffusing the substance over time in the wearer's saliva (see summary of the invention). It would have been obvious to one of ordinary skill in the art, having the disclosures

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of Kaping, Jr. and Sipos before him at the time the invention was made, to modify the mouth and tongue stud of Kaping, Jr. to include means for dispensing a substance formed in a portion of the stud (and therein on or below, or on and below, the wearer's tongue), wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, and wherein an insert is disposed in the means for dispensing a substance and dispensing the substance into the wearer's mouth, wherein the substances is dispensed by diffusing the substance over time in the wearer's saliva, as in Kasdin. One would have been motivated to make such a combination because such a configuration of the mouth and tongue stud will provide to the user a convenient and reliable means to deliver active substances, such as a breath freshener to the user in uniform dosage over an extended period of time (see summary of the invention), as taught by Sipos. Moreover, it would have been obvious to a person of ordinary skill in the art to have modified the mouth and tongue stud of Sipos, as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because the means for dispensing a substance into a mouth as claimed has the properties predicted by the prior art of Sipos, it would have been obvious to make the alteration in order to gain the commonly understood benefits and applications of such an adaptation and/or modification.

Re: Claims 48, wherein the substance comprises a liquid (see summary of the invention, as well as col. 2, beginning with line 61).

[4] Claims 31 and 37, 39, 42-43, 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr., US-6,026,659, in view of Cox, US-4,959,052.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claims 31, 37, 39, and 45, Kaping, Jr. teaches of a method comprising the steps of providing a mouth and tongue stud, wherein the stud further comprises a bar (12) having ends, a first end member (14) attached to one end of the bar and a second end member (16) attached to an other end of the bar, and the first end member (14) removably attaches to the one end of the bar; mounting the bar (12) of the stud in a fistula formed in a wearer's tongue.

The difference between the claim and Kaping, Jr. is that Kaping, Jr. does not expressly disclose of the bar possessing a means for dispensing a substance formed in a portion of the stud, wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, wherein the substances is dispensed into the wearer's mouth solely by dissolving the substance over time in the wearer's saliva so that he dissolved substances is free to flow from the means for dispensing into the wearer's mouth. Cox discloses a method for dispensing a substance such as medicaments, antibiotics, nutrients, oral care agents, and the like, in the area of the mouth of a wearer. In addition, Cox further teaches that the means (4, 5) for dispensing a substance (12) formed in a portion of the applicator, wherein the means (4,5) for dispensing a substances contains the substances (12) and dispensing the substance (12) into the wearer's mouth, wherein the substances (12) is dispensed into the wearer's mouth solely by dissolving the substance (12) over time in the wearer's saliva so that he dissolved substances

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is free to flow from the means (4,5) for dispensing into the wearer's mouth (see col. 2, line 44, "...dispense active substances...by means of the number, size or shape of the passage openings, the flow of saliva available for the dissolution and emission of the active substances..."). In addition, Cox also teaches of an insert, such as 3 in fig. 3 (claim 37) and of the substance (12) being in the form of solid (crystallized form) and tablet form (claims 42-45).

It would have been obvious to one of ordinary skill in the art, having the disclosures of Kaping, Jr. and Cox before him at the time the invention was made, to modify the mouth and tongue stud of Kaping, Jr. to include means for dispensing a substance formed in a portion of the stud (and therein on or below, or on and below, the wearer's tongue), wherein the means for dispensing a substances contains the substances and dispensing the substance into the wearer's mouth, wherein the substances is dispensed into the wearer's mouth solely by dissolving the substance over time in the wearer's saliva so that he dissolved substances is free to flow from the means for dispensing into the wearer's mouth, as in Cox. One would have been motivated to make such a combination because such a configuration of the mouth and tongue stud will provide to the user a convenient and reliable means to deliver active substances such as medication to the user in uniform dosage over an extended period of time (see background of the invention), as taught by Cox. Moreover, it would have been obvious to a person of ordinary skill in the art to have modified the mouth and tongue stud of Kaping, Jr., as a person with ordinary skill has good reason to pursue the known options within his or her technical grasp. In turn, because the means for dispensing a substance into a mouth as claimed has the properties predicted by the prior art of Cox, it would have been obvious to make the alteration in order to

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gain the commonly understood benefits and applications of such an adaptation and/or modification.

Re: Claims 47, Kaping, Jr., teaches wherein the bar (12) is a solid bar that is without an internal cavity, and the means for dispensing a substance is formed in the second end member (after the modification in view of Cox, it would be obvious to place the substance in any part of said mouth and tongue stud).

[5] Claim 49 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaping, Jr., US-6,026,659, in view of Cox, US-4,959,05, and in further in view of Kasdin, US-3,503,127.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 49, Kaping, Jr. in view of Cox teach that of the above claims. The difference between the claim and Kaping, Jr., in view of Cox is that Kaping, Jr., in view of Cox does not expressly state of the substance comprising a liquid. Kasdin teaches of a method for dispensing a substance such as a pill in the area of the mouth of a wearer. In addition, Kasdin further teaches that instead of the substance being a pill, it can also be a mixture of a sweet smelling solution (see summary of the invention, as well as from col. 2, beginning with line 61). It would have been obvious to one of ordinary skill in the art, having the disclosures of Kaping, Jr., in view of Cox and Kasdin before him at the time the invention was made, to modify the

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means for dispensing a substance to have the substance include that of a liquid, as in Kasdin.

One would have been motivated to make such a combination for more efficient dissolution and uptake of the medicine to the user.

Response to Arguments

[6] Applicant's amendment and arguments filed 7/12/2010 regarding rejections under 35 U.S.C. 103 have been fully considered but they are not persuasive. In the instant case, the applicant amended each and every independent claim; changing “into the wearer’s mouth” to “on or below, or on and below, the wearer’s tongue.” As explained below, the examiner maintains that the prior art of Kaping, Jr., in view of the various other references, remain applicable in view of this current, amended subject matter. First and foremost, it is extremely pertinent to point out that the primary reference, Kaping, Jr., is body jewelry device that is for use in a tongue of a wearer. This body jewelry device, as described above, is the reference that is modified with means for dispensing a substance. Since the body jewelry device is already in use as a tongue stud, the newly submitted claim limitation of “on or below, or on and below, the wearer’s tongue” will thus be met.

Applicant’s first argument, that the references fail to teach each and every limitation of the claims as amended is misplaced. Applicant bases this argument on an extensive piecemeal analysis of the references, merely going through each reference and stating what parts of the claim the reference does not have. In response to Applicant’s piecemeal analysis of the references, it has been held that one cannot show non-obviousness by attacking references individually where, as here, the rejections are based on combinations of references. *In re Keller*, 208 USPQ 871 (CCPA 1981). As shown and described above, when one properly views the

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combination of the references each and every claimed limitation is indeed met. Moreover, it has been held that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. *In re Bozek*, 163 USPQ 545 (CCPA 1969).

After attacking each reference solely without considering the combination of references as articulated above by the examiner, the applicant then attacks each reference as being nonanalogous art. Again, this argument is misplaced. As correctly noted by applicant, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. *In re Wood*, 202 USPQ 171, 174. In this case, both prongs are actually met. The instant invention deals with a tongue stud for dispensing a substance in the mouth of a wearer. Each of the prior art utilized in the above combination with Kaping (who teaches of a tongue stud) is used in a wearer's mouth, to dispense a substance into a wearer's mouth.

Next, the applicant argues that there is no legitimate reasons to combine the disclosures of the prior art with the primary art of the Kaping Patent; the applicant's reasoning stemming from his previous arguments. Again, the examiner disagrees and maintains that when one properly views the combination of references, each and every claimed limitation is met, and also, that the prior art is indeed analogous.

Lastly, the applicant argues that there is no reasonable expectation of success even if the combinations proposed by the examiner were made. Applicant seems to base this theory on the

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assertion that a person of ordinary skill in the art would have lacked sufficient guidance to successfully modify Kaplan's bar bell secure to arrive at the presently claimed invention. Again, the examiner disagrees. The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. *In re Keller*, 642 F. 2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In this regard, a conclusion of obviousness may be based on common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. *In re Bozek*, 416 F. 2d 1385, 1390, 163 USPQ 545, 549 (CCPA 1969). Even more pertinent, the examiner would also like to point out that KSR forecloses the argument that a specific teaching, suggestion, or motivation is required to support a finding of obviousness. Ex parte Smith, -- USPQ2d--, slip op. at 20, (Bd. Pat. App. & Interf. June 25, 2007). Rather, the determining of obviousness does not require staying within the object of Kaping, "The question is not whether the combination was obvious to the patentee but whether the combination was obvious to a person with ordinary skill in the art." *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1397 (2007). In making the obviousness determination one "can take account of the inferences and creative steps that a person of ordinary skill in the art would employ." *KSR*, 127 S.Ct. at 1741, 82 USPQ2d at 1396. "A person of ordinary skill is also a person of ordinary creativity, not an automaton." *KSR*, 127 S.Ct. at 1742. 82 USPO2d at 1397.

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Conclusion

[7] **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

[8] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached at (571) 272-6987. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DAVID REESE/
Examiner, Art Unit 3677